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EXAMINER

SHAFFER, ERIC T

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/672,483

Applicant(s)

MCELROY ET AL.

Examiner

Eric T. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The following is an initial Office Action upon examination of the above-identified application on the merits. Claims 1 - 46 are pending in this application.

#### ***Rejections - 35 USC § 112***

2. Claims 1 – 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, without undue experimentation. The applicant does not provide enough detailed information to specifically describe what steps are involved in the production, diffusion and application of organizational knowledge. Similarly, no steps are given by the applicant to specifically describe how to develop or implement an embryonic policy, a knowledge policy, a diversity policy, a connectivity policy to enable one of ordinary skill in the art to construct such a device from the applicant's disclosure without undue experimentation.

#### ***Claim Rejections - 35 USC § 101***

3. Claims 1 – 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, invoke, use, or advance the technological arts.

In the present case, the method of proposing a knowledge policy does not specifically use technology to carry out any of the non-trivial claimed method steps. For example, the steps of claim 1 of developing a knowledge, embryology, politics, diversity, connectivity and practice may be performed manually or without the aid of any technology. Thus, claims 1 – 30 do not affect, effect, or are affected by technology, and thus do not recite statutory subject matter. Use of a computer, a computer operable medium, or some other technology device is required for said claims to be patentable.

The claims 1 – 30, do meet the second part of the two-prong test of producing useful, concrete and tangible result, the claimed invention. Use of the term enhancing denotes that a system currently exist to perform this function, yet the applicant has not revealed such a system. The applicant's proposed method does not result in a system that produces any tangible result as the method merely discusses proposing and evaluating various policies. In order to meet the standards of the two-pronged test, the applicant's invention must produce a tangible result such as a document, a list, or a step-by-step formal procedure that is usable by someone charged with making the invention.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 8, 10 – 23 and 25 – 30 are rejected under 35 U.S.C. 102(b) as being anticipated by the Book “The Innovator’s Handbook” published in 1989.

As per claims 1 and 16, “The Innovator’s Handbook” discloses a human social system having a tendency to self organize around one or more of the production, diffusion and application of organizational knowledge, a method of enhancing one or more of the production (page 87, “brainstorming”), diffusion (page 169, “Briefing Meetings”) and application (page 91, “a five-step strategy for managing the creative resource”) of such knowledge comprising synchronizing knowledge policies with said tendency.

5. As per claims 2 and 17, “The Innovator’s Handbook” discloses a method, as claimed in claim 1, wherein said synchronizing comprises:

proposing a knowledge embryology policy for the social system (page 42, “some springboards may be embryonic solutions which need development”);

proposing a knowledge politics policy for the social system (page 80, “a creative consensus is a Win/Win ; all parties are satisfied”);

proposing a knowledge diversity policy for the social system (page 35, “all ideas are potentially valuable to the solution of a problem”);

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proposing a knowledge connectivity policy for the social system (page 170, “a consultation meeting is one in which a manager collects opinions and ideas prior to making a decision”), where connectivity is communication between managers in order to facilitate the flow of ideas;

practicing at least one but less than all of the proposed knowledge embryology, politics, diversity and connectivity policies in the social system (page 60, “idea development is the process by which an embryonic new idea, which is attractive but not yet feasible, is converted into a practical solution”), where developing a practical solution is a policy in practice;

evaluating the practice of said at least one but less than all proposed knowledge policies in the social system (page 66, “Evaluation: pluses”);

practicing the remaining unevaluated proposed policies from the group consisting of the proposed knowledge embryology, politics, diversity and connectivity policies with the evaluated at least one but less than all proposed knowledge policies in the social system (page 17, “a balanced appraisal will identify all the good features of the present situation, as well as the areas that need improvement”).

6. As per claims 3 and 18, “The Innovator’s Handbook” discloses a method, as claimed in claim 2, wherein the at least one but less than all proposed knowledge policies comprises only the proposed knowledge politics policy and wherein the remaining unevaluated proposed policies comprises the proposed knowledge embryology policy, the proposed knowledge diversity policy and the proposed knowledge connectivity policy (page 17, “a balanced appraisal

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will identify all the good features of the present situation, as well as the areas that need improvement”).

7. As per claims 4 and 19, “The Innovator’s Handbook” discloses a method, as claimed in claim 2, wherein said proposing a knowledge embryology policy comprises:

determining an existing knowledge embryology practice and policy of the social system (page 69, “determine the present position”);

determining conflicts between the existing knowledge embryology policy and proposed knowledge embryology policy (page 81, “behind opposed positions lie shared and compatible interests as well as conflicting ones”);

determining requirements to resolve said conflicts (page 70, “identify the action steps you intend to take. A finished idea needs to satisfy the criteria of being new, appealing and feasible”).

8. As per claims 5 and 20, “The Innovator’s Handbook” discloses A method, as claimed in claim 2, wherein said proposing a knowledge politics policy comprises:

determining an existing knowledge politics practice of the social system (page 69, “describe the present position”);

determining conflicts between the existing knowledge politics policy and proposed knowledge politics policy (page 81, “Interests: behind opposed positions lie shared and compatible interests as well as conflicting ones”);

determining requirements to resolve said conflicts (page 80, “a creative consensus is an outcome that pleases all parties”).

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9. As per claims 6 and 21, “The Innovator’s Handbook” discloses a method, as claimed in claim 2, wherein said proposing a knowledge diversity policy comprises:

determining an existing knowledge diversity practice and policy of the social system (page 34, “all ideas are potentially valuable to the solution of the problem”);

determining conflicts between the existing knowledge diversity policy and the proposed knowledge diversity policy (page 35, “do not need to make judgements about which ideas are useful and which are not”);

determining requirements to resolve said conflicts (page 35, “switch off judgemental faculties altogether as I listen in this way”).

10. As per claims 7 and 22, “The Innovator’s Handbook” discloses a method, as claimed in claim 2, wherein said proposing a knowledge connectivity policy comprises:

determining an existing knowledge connectivity practice and policy of the social system (page 69, “describe the present position”);

determining conflicts between the existing knowledge connectivity policy and proposed knowledge connectivity policy (page 131, “questions to check whether an idea is feasible”);

determining requirements to resolve said conflicts (page 173, “conflict resolution”).

11. As per claims 8 and 23, “The Innovator’s Handbook” discloses a method, as claimed in claim 2, and further comprising determining at least one characteristic of the innovation of the social system (pages 2 – 3, “the most important difference between innovation and routine management lies in the attitudes toward and the handling of risks”).

12. As per claims 10 and 25, “The Innovator’s Handbook” discloses a method, as claimed in claim 8, wherein the one characteristic comprises innovation quality (page 86,



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“attribute listing can be used as a tool for value analysis, by relating the cost of each component to the function it performs”), where cost benefit is an aspect of the feasibility quality of an innovation.

13. As per claims 11 and 26, “The Innovator’s Handbook” discloses a method, as claimed in claim 8, and further comprising refining at least one of said proposed knowledge embryology policy, said proposed knowledge politics policy, said proposed knowledge diversity policy and said proposed knowledge connectivity policy in response to said at least one characteristic (page 70, “continue in this sequence until you have reached an idea that you think is worth implementing. Repeat steps 4 to 7 as necessary to develop as many new courses of action as you want and as many as you have the capability to implement”).

14. As per claims 12 and 27, “The Innovator’s Handbook” discloses a method, as claimed in claim 2, wherein said practicing the proposed knowledge embryology policy, proposed knowledge diversity policy and proposed knowledge connectivity policy with the evaluated proposed knowledge politics policy in the social system comprises:

practicing the proposed knowledge embryology policy with the evaluated proposed knowledge politics policy (page 65 – 66, “example of idea development”);

evaluating the proposed knowledge embryology policy and evaluated proposed knowledge politics policy as practiced together in the social system (page 66, “Evaluation: pluses”);

practicing the evaluated proposed knowledge embryology policy, twice evaluated proposed knowledge politics policy, proposed knowledge diversity policy and proposed knowledge connectivity policy together in the social system (page 70, “continue in this

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sequence until you have reached an idea that you think is worth implementing. Repeat steps 4 to 7 as necessary to develop as many new courses of action as you want and as many as you have the capability to implement”).

15. As per claims 13 and 28, “The Innovator’s Handbook” discloses a method, as claimed in claim 12, and further comprising refining the proposed knowledge embryology policy, proposed knowledge politics policy, proposed knowledge diversity policy and proposed knowledge connectivity policy in response to said practicing the evaluated proposed knowledge embryology policy, twice evaluated proposed knowledge politics policy, proposed knowledge diversity policy and proposed knowledge connectivity policy together in the social system (page 70, “continue in this sequence until you have reached an idea that you think is worth implementing. Repeat steps 4 to 7 as necessary to develop as many new courses of action as you want and as many as you have the capability to implement”).

16. As per claims 14 and 29, “The Innovator’s Handbook” discloses a method, as claimed in claim 2, wherein said social system comprises an organization (page 95, “down the organization, the targets for creativity might generate quality circles and suggestion schemes for tapping into the creative contribution of all employees”).

17. As per claims 15 and 30, “The Innovator’s Handbook” discloses a method, as claimed in claim 14, wherein said organization comprises a business (page 95, “creativity can be applied to the most critical areas, the strategic needs of the business”).

***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

19. Claim 31 is rejected under 35 U.S.C. 102(e) as being anticipated by Reddy (US 6,629,096).

As per claim 31, Reddy discloses a In a human social system having a tendency to self organize around one or more of the production, diffusion and application of organizational knowledge, said system including a data store and a communication network, a method of supporting the enhancing of one or more of the production, diffusion and application of said organizational knowledge and the synchronizing of knowledge policies with said tendency, said method comprising:

storing data (column 5, lined 44 - 45, “data warehouse is coupled to mindflow management module and comprises a repository for data items”) relating to one or more of said organizational knowledge and knowledge policies in said data store (column 6, line 33 -35, “these knowledge items generally represent those strategies, ideas, and solutions developed by a knowledge worker making business decisions”);

communicating over said network to facilitate said synchronizing (column 5, lines 1-2, “the components of the system may be part of a local area network”).

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20. As per claim 44, Reddy discloses a method, as claimed in claim 31, wherein said system comprises a data processor and wherein said method further comprises processing data relating to one or more of said organizational knowledge and knowledge policies with said data processor (column 12, lines 30 – 31, “process of module comprises any suitable combination of hardware and software in computer”).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 32 – 38 and 40 - 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy (US 6,629,096) in view of the Book “The Innovator’s Handbook” published in 1989.

As per claims 32 – 37 and 41 - 43, Reddy teaches a computer operable network communication system and method for knowledge generation, storage and retrieval for the purpose of providing business analysis and support of the problem solving process. The system incorporates “strategies, ideas and solutions developed by a knowledge worker” (column 6, lines 33 -35) in the process of solving day-to-day business problems. Reddy teaches documenting the mindflow thought process of solving a problem in order to create an audit trail of documents that others can read and improve upon. Reddy however, does not teach solving a problem by using a specific method of the knowledge embryology, politics, diversity and connectivity policies in the

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social system. It would be useful to link the Reddy system with a specific problem solving methodology in order to take advantage of the database of problem solving documents.

“The Innovator’s Handbook” does in fact teach each element of a knowledge embryology policy for the social system (page 42); a knowledge politics policy for the social system (page 81); a knowledge diversity policy for the social system (page 35); a knowledge connectivity policy for the social system (page 170); and using these policies in practice.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the computer operable processor and memory elements of the Reddy knowledge management system with “The Innovator’s Handbook” knowledge management method in order to develop a system that would provide a greater degree of organization to the data involved in generating ideas and to better enable the dissemination of said ideas throughout an organization by using a communications network. Since innovation is based on generating a large number of ideas and having a multitude of people review and improve on such ideas, a communications network that facilitates this traffic in ideas would be an obvious improvement on the “Innovator’s Handbook” methodology.

23. As per claim 38, Reddy teaches a method, as claimed in claim 32, and further comprising using data from said data store to determine at least one characteristic of the innovation of the social system (column 11, lines 40, “a new cost-savings opportunity to implement”).

24. As per claim 40, Reddy teaches a method, as claimed in claim 38, wherein the one characteristic comprises innovation quality (column 11, lines 59 – 62, “knowledge item accumulation module may assign a weighting factor to the new knowledge item based

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upon quantifiers identifying the success of the selected knowledge module using the new knowledge”).

25. As per claim 45, Reddy teaches a method, as claimed in claim 32, wherein said social system comprises an organization (column 12, lines 62, “a knowledge module to perform any suitable business task of an organization”).

26. As per claim 46, Reddy teaches a method, as claimed in claim 45, wherein said organization comprises a business (column 12, line 53 – 54, “a process that performs a particular business task”).

27. Claims 9, 24 and 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy (US 6,629,096) in view of the book “The Innovator’s Handbook and in further view of the book “Diffusion of Innovation” published in 1983.

28. As per claims 9, 24 and 39, Reddy teaches a computer operable network communication system and method for knowledge generation, storage and retrieval for the purpose of providing business analysis and support of the problem solving process. The system incorporates “strategies, ideas and solutions developed by a knowledge worker” (column 6, lines 33 -35) in the process of solving day-to-day business problems. Reddy teaches documenting the mindflow thought process of solving a problem in order to create an audit trail of documents that others can read and improve upon. Reddy however, does not teach a rate of solving a problem or innovation by using a specific method of the knowledge embryology, politics, diversity and connectivity policies in the social system. It would be useful to link the Reddy system with a

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specific problem solving methodology in order to take advantage of the database of problem solving documents.

“The Innovator’s Handbook” does in fact teach each element of a knowledge embryology policy for the social system (page 42); a knowledge politics policy for the social system (page 81); a knowledge diversity policy for the social system (page 35); a knowledge connectivity policy for the social system (page 170); and using these policies in practice.

“The Innovator’s Handbook” does not teach a rate of innovation. It would be obvious to do so in order to determine if and how fast an organization was innovating relative to other innovative organizations.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the computer operable processor and memory elements of the Reddy knowledge management system with “The Innovator’s Handbook” knowledge management method in order to develop a system that would provide a greater degree of organization to the data involved in generating ideas and to better enable the dissemination of said ideas throughout an organization by using a communications network. Since innovation is based on generating a large number of ideas and having a multitude of people review and improve on such ideas, a communications network that facilitates this traffic in ideas would be an obvious improvement on the “Innovator’s Handbook” methodology.

“Diffusion of Innovation” teaches a plurality of methods for measuring the success, quality, and rate of an innovative system and the people responsible for managing an innovative organization. The book also teaches a “rate of awareness knowledge” and a “rate of adoption” (page 204, figure 5.5).

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It would have further been obvious to one of ordinary skill in the art at the time the invention was made to combine the computer operable processor and memory elements of the Reddy knowledge management system and the ideas taught by “The Innovator’s Handbook” with the rate of innovation taught in the “Diffusions of Innovation” textbook because such a system would allow organization desiring to implement innovative thinking policies to see how fast their organizations are progressing with respect to other organizations that have been innovative for a longer period of time.



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***Conclusion***

29. No claims were allowed and all claims were rejected.
30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baffes et al. (US 6,292,792) – Knowledge generation and distribution system  
Hayashi et al (US 6,101,488) – Information generation and retrieval system  
Reddy (US 6,519,578) – Knowledge warehouse system

31. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Shaffer whose telephone number is (703) 305-5283. The Examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington D.C. 20231

Or faxed to:

(703) 746-7238 [After Final communications, labeled "Box AF"]  
(703) 746-7239 [Official communications]  
(703) 706-9124 [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 7<sup>th</sup> floor receptionist.

ETS

December 22, 2003

*Romain Jeanty*  
Primary Examiner  
Art Unit 3623